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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,943	11/03/2003	Kelly Gravelle	114944-00434	5033

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BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

PAIK, STEVE S

ART UNIT	PAPER NUMBER
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2876

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/698,943	Applicant(s) GRAVELLE, KELLY	
	Examiner Steven S. Paik	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 and 51 is/are rejected.
- 7) ☒ Claim(s) 50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Amendment and Remarks filed January 22, 2007.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slavin et al. (US 5,819,234) in view of Davis et al. (US. 5,892,211).

Re claims 1-3, 14-16, 26, 32-34, 45 and 51, Slavin discloses an automatic toll collection system and method comprising and operating in conjunction with transponders (an electronic toll collection device) which are provided for sale to the public in sealed packages and which are pre-approved for a predetermined amount of prepaid toll credit. When the transponders are purchased, they can be installed in any vehicle and are immediately ready for use. The kit in which the transponder is sold includes application forms and a return mailer which permit the purchaser thereof to convert the pre-established anonymous account to a regular prepaid toll account and to authorize the automatic replenishment of the account (this may be done via the Internet), thus enabling continued use of the purchased transponder beyond the pre-approved amount. The invention further comprises the process of frequent updating, e.g. several times daily, hourly, etc. of toll plaza computers with toll transactions at all participating toll facilities, to prevent inadvertent overdrawing of toll accounts by motorists. Slavin further discloses that

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the transponder, which may be distributed by a participating retail establishment such as a Seven-Eleven TM or Wal-Mart TM or through the mail, is encoded at a central billing computer facility (CSC) with a predetermined toll balance amount, for example \$25. The toll collection system also includes a communication link (Internet) for providing communication between the processing device and a remote computer (central computer), and wherein the processing device provides the stored value (predetermined toll balance amount) by transmitting the stored value to the remote computer. It is then enclosed in a protective foil wrapper to shield it from unintentional use and packaged in a sealed kit for distribution to vendors and sale.

Slavin fails to explicitly disclose an electronic toll collection device that may be purchased at the self-service transactional terminal.

Davis discloses a device comprising a self-service transactional terminal (POS terminal 40 or vending machine terminal 50). The self-service transactional terminal comprises a payment acceptance device (a coin and/or bill receiving device 56) for accepting payment for a user-selected good/service, a dispenser (a dispensing opening 54) to dispense the user-selected good/service, and a processing device (col. 7, ll. 8-12), in electronic communication with the payment acceptance device and the dispenser, for providing a stored value of the user-selected good/service and controlling the dispenser to dispense the user-selected good/service in accordance with the payment accepted by the payment device. The user-selected good/service may be anything that an operator of the self-service transaction terminal provides. For example, if a booklet of stamps is provided by an operator of an ATM (another example of a self-service transaction terminal), a user may select an option to buy a booklet of stamp at the terminal.

Generally, a plurality of ATMs are connected via a communication link and each ATM is located

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at a different location. A self-service transactional terminal or a standalone vending machine is one of many well known retail establishments in the art.

Therefore, it would have been obvious at the time the invention was made to a person having of ordinary skill in the art to sell the electronic toll collection device of Slavin using the self-service transaction terminal of Davis for the purpose of encouraging the usage of the electronic toll collection device while increasing the convenience of acquiring the device and operation of the device.

Re claims 4 and 17, Slavin in view of Davis discloses the system and method as recited in the rejected claims 1 and 5 stated above further comprising a display, in electronic communication with the processing device, for guiding a user in purchasing the electronic toll collection device (col. 5, line 19 - col. 6, line 17 of Davis).

Re claims 5 and 18, Slavin in view of Davis discloses the system and method as recited in the rejected claims 4 and 17 stated above, wherein the display comprises a touch screen for both guiding the user and receiving commands from the user (col. 4, ll. 22-39).

Re claims 6, 19 and 37, Slavin in view of Davis discloses the system and method as recited in the rejected claims 4, 17 and 35 stated above, further comprising a key pad (key pad 36 or keyboard 42) for receiving commands from the user.

Re claims 7, 20 and 38, Slavin in view of Davis discloses the system and method as recited in the rejected claims 1, 15 and 32 stated above, wherein the payment acceptance device comprises a cash acceptor for accepting the payment in cash (col. 6, ll. 57-65).

Re claims 8, 21 and 39, Slavin in view of Davis discloses the system and method as recited in the rejected claims 7, 20 and 32 stated above, wherein the payment acceptance device

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further comprises a card reader (col. 7, ll. 1-10) for accepting the payment in electronic form through a card (SVC 20).

Re claims 9 and 22, Slavin in view of Davis discloses the system as recited in the rejected claims 1 and 15 stated above, wherein the payment acceptance device comprises a card reader (col. 7, ll. 1-10) for accepting the payment in electronic form through a card (SVC 20).

Re claims 10, 23, 27 and 40, Slavin in view of Davis discloses the system and method as recited in the rejected claims 1, 15 and 32 stated above, further comprising an input device for receiving a number (a unique tag number) of an existing electronic toll collection device, wherein the processing device increases the stored value for the existing electronic toll collection device in accordance with the payment accepted by the payment acceptance device. Slavin discloses a replenishment process of an existing tag account through the customer service center 72, which may be a self-service vending machine as discussed above.

Re claims 11, 24, 41 and 46, Slavin in view of Davis discloses the system and method as recited in the rejected claims 10, 23, 40 and 45 stated above, wherein the input device comprises a user input device for manual input of the number (via a keypad or a keyboard of a computing device of Davis).

Re claims 12, 25, 42 and 47, Slavin in view of Davis discloses the system and method as recited in the rejected claims 10, 23, 40 and 45 stated above, wherein the input device comprises a reader (bar code scanner; col. 5, ll. 49-52) for automatically reading the number from the electronic toll collection device.

Re claims 13, Slavin in view of Davis discloses the system as recited in the rejected claim 1 stated above, further comprising a bar code reader, in electronic communication with the

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processing device, for reading a bar code from a document and for transmitting information in the bar code to the processing device, wherein the processing device associates the information in the bar code with payment accepted by the payment acceptance device (bar code scanner; col. 5, ll. 49-52).

Re claim 14, Slavin in view of Davis discloses the system as recited in the rejected claim 1 stated above, wherein the dispenser comprises a dispenser for issuing motor vehicle tax or license decals.

Re claims 28, 43, 48 and 49, Slavin in view of Davis discloses the system and method as recited in the rejected claims 27, 40, and 45 stated above, wherein the accounting computer is in communication with a violation processing center (col. 5, line 54 - col. 6, line 4 of Slavin) and controls the violation processing center not to process a toll violation if the stored value is increased within a predetermined time period after the violation.

Re claim 29, Slavin in view of Davis discloses the system as recited in the rejected claim 28 stated above, wherein the vending unit further comprises a bar code reader, in electronic communication with the processing device, for reading a bar code from a document and for transmitting information in the bar code to the processing device, wherein the processing device transmits the information in the bar code to the accounting computer for association with the payment accepted by the payment acceptance device (col. 5, ll. 49-56 of Davis).

Re claims 30 and 44, Slavin in view of Davis discloses the system and method as recited in the rejected claims 26 and 32 stated above, wherein the accounting computer is in communication with a toll facility (Roadside Collection Stations) at which the electronic toll collection device is usable for paying a toll, and wherein, when the electronic toll collection

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device is used at the toll facility, the accounting computer deducts the toll from the stored value (col. 5, ll. 53+ of Slavin).

Re claim 31, Slavin in view of Davis discloses the system as recited in the rejected claim 26 stated above, wherein the accounting computer is in communication with a computer system operated for a public authority (central computer 40) for collection of motor vehicle taxes or fees, and wherein the accounting computer (local plaza computer 32) communicates an amount of the payment accepted by the payment acceptance device to the computer system operated for the public authority.

Re claim 35, Slavin in view of Davis discloses the system and method as recited in the rejected claim and 32 stated above, wherein the vending unit (vending machine terminal 50) comprises a display (532), wherein in step (a) comprises guiding the user through the display in purchasing the electronic toll collection device (col. 5, line 19 - col. 6, line 17 of Davis).

Re claim 36, Slavin in view of Davis discloses the system and method as recited in the rejected claim 32 stated above, wherein the display comprises a touch screen for both guiding the user and receiving commands from the user, and wherein the method further comprises receiving the commands from the user through the touch screen (col. 4, ll. 22-39 of Davis).

Allowable Subject Matter

4. Claim 50 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the cited prior arts of the record teaches, discloses or fairly suggests the claimed step of

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reading a barcode from a violation notice issued pursuant to the toll violation and communicating information in the bar code to the violation processing center.

Response to Arguments

5. Applicant's arguments filed January 22, 2007 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Davis reference provides general teachings of a vending machine which can be a standalone terminal and a retail establishment by itself. Therefore, the examiner believes there are clear teaching, suggestion, and motivation to combine the teachings of Slavin et al. (US 5,819,234) and Davis et al. (US. 5,892,211).

The applicant argues that there would be no transmission of the stored value from the vending unit to a remote computer for maintaining account information regarding the electronic toll collection device. As previously discussed, the teachings of Davis et al. are mainly applied to cure the deficiency of lacking a vending unit retail setting. The vending unit of Davis et al. shown in figures 1, 2 and 5 discloses an item (52) selected by a buyer is dispensed via a dispensing unit (54). The reference is not limiting the items sold at the vending unit to a particular item. It is obvious to an artisan of ordinary skill in the art to incorporate the vending

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unit of Davis et al. with a Customer Service Center (CSC 72) of Slavin et al. to minimize operating cost of CSC center by replacing an operator-assisted retail setting with a self-service vending unit. The CSC is in communication with a remote computer to accurately maintain the current value of a pre-paid transponder.

The applicant further argues that the replenishment of the transponder taught in Slavin et al. happens after the transponder is sold and is thus irrelevant to the operation of the vending unit. In response to applicant's argument, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Accordingly, claims 1-49 and 51 remain rejected.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Monday - Friday 6:30a-3:00p (Maxi-Flex*).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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ssp